

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/726,589
First Named Inventor : Erik KRIMM
Filed : December 1, 2000
TC/A.U. : 3679
Examiner : Ernesto Garcia

Confirmation No. : 1848

RECEIVED
CENTRAL FAX CENTER
SEP 06 2005

Docket No. : 038738.49427US
Customer No. : 23911

Title : Gear Shift Mechanism Gate Plate Assembly and Method for
Producing Same

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22318-1450

APPEAL BRIEF

Sir:

On February 3, 2005, Appellants appealed to the Board of Patent Appeals from the final rejection of Claims 1, 4, 8, 20, 24, and 25. The following is Appellants' Appeal Brief submitted pursuant to 37 C.F.R. §41.37.

Applicant hereby requests that the period to take action in the above-captioned application be extended by five months pursuant to the provisions of 37 C.F.R. 1.136(a). A check which includes the amount of \$2,160.00 is submitted herewith in payment of the required extension fee. This amount is believed to be correct, however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 05-1323 (Docket No.038738.49427US).

Real Party in Interest

This application is assigned to DaimlerChrysler AG of Stuttgart, Germany, which is the real party in interest in this appeal.

09/07/2005 CNGUYEN 00000033 051323 09726589

02 FC:1402 500.00 DA

Page 1

Application No. 09/726,589
Appeal Brief
September 6, 2005

Related Appeals and Interferences

Applicants and their counsel are not aware of any related appeals or interferences which would affect, be affected by, or have a bearing on the instant appeal.

Status of Claims

Claims 1, 4-8, 20, 24, and 25 are pending and under examination. Claims 1, 4, 8, 20, 24, and 25 are finally rejected and form the subject of this appeal.

Status of Amendments

Applicants filed an Amendment on August 9, 2005 to place Claims 5-7 in allowable form. The Amendment has not been entered.

Summary of Claimed Subject Matter

In accordance with one aspect of the invention, the claimed invention relates to a functional component such as a gate plate of an automatic gear shift mechanism with a locking gate. The functional component includes at least three stamped parts (1, 18, 19), which lie flat sandwiched against one another and are unreleasably connected to one another (Figs. 4 and 5). Each stamped part has at least two engagement holes (4, 5) for engagement elements, and the engagement holes (4, 5) of the stamped parts (1, 18, 19) are arranged congruently with respect to one another (Figs. 1, 3 and 5). At least one of the middle stamped part's holes (4, 5) has a hole wall (8) which is provided with an elastomeric plastic cover (9) (Figs. 1 and 2). The plastic cover (9) may be formed by injection-moulded plastic around the hole edge (10).

The functional component may also include injection-moulded plastic connecting webs (12), which are on a base surface (11) of the middle stamped part (1) and extend from the injection-moulded plastic around the hole edge (10)

Application No. 09/726,589
Appeal Brief
September 6, 2005

(Fig. 1). The functional component may further include plug-in domes (13) that are formed from the webs (12) and project from the base surface (11) of the middle stamped part (1) (Figs. 1, 2 and 5). The two outer stamped parts (18, 19) include passage holes (15) dimensioned to receive the plug-in domes (13) (Figs. 3 and 5).

The middle stamped part (1) may include passage holes (15) at the locations of the plug-in domes (13) (Figs. 1 and 5). The plug-in domes (13) or the connecting webs (12) on one side (16, 17) of the middle stamped part (1) are joined integrally to the plug-in domes (13) or the connecting webs (12) on the other side (16, 17) of the middle stamped part (1) via the passage holes (15) of the middle stamped part (1) (Fig. 5).

The plug-in domes (13) may extend into, and project out of, the passage holes (15) of the outer stamped parts (18, 19), and bear against the outer sides (21) of the outer stamped parts (18, 19) in the form of flat heads (22) which are wider than the passage holes (15) (Fig. 5).

Spacer lugs (20) may be formed from a material which is harder than the injection-moulded plastic on the inner sides (24) of the outer stamped parts (19, 20) which face towards the middle stamped part (1) (Fig. 3).

In accordance with another aspect of the invention, the claimed invention relates to a gate plate for an automatic gear shift mechanism which has engagement holes (4, 5) for glidingly accommodating movable gear shift mechanism engagement elements (Figs. 1-5). The gate plate includes at least three stamped metal sheet parts (1, 18, 19) stacked together sandwiched (Figs. 4 and 5). Each of the metal sheet parts (1, 18, 19) includes at least one engagement hole (4, 5) aligned with engagement holes (4, 5) in the other metal sheet parts (1, 18, 19) (Fig. 5). An elastomeric plastic cover (9) is provided to surround at least a portion of the engagement hole (5) in the middle one (1) of the metal sheet parts (1, 18, 19) (Figs. 1 and 2). The elastomeric plastic cover (9)

Application No. 09/726,589
Appeal Brief
September 6, 2005

may be clicked into place on the metal part (1) and may be injection-moulded onto the middle part (1) (Figs. 1 and 2).

Grounds of Rejection to Be Reviewed on Appeal

Claims 1, 4, 8, 20, 24, and 25 have been rejected under 35 U.S.C. §102(e) as being anticipated by *Sander* (US 6,182,527).

Argument

The Examiner finally rejected Claims 1, 4, 8, 20, 24, and 25 under 35 U.S.C. §102(e) as being anticipated by *Sander* (US Patent 6,182,527). The final rejection is improper because Applicants' Declaration, submitted under 37 CFR 1.131 with the February 11, 2004 Amendment, establishes that the *Sander* patent is not prior art under 35 U.S.C. §102(e).

I

When any claim of an application is rejected, a declaration may be submitted to establish invention of the subject matter of the rejected claim prior to the effective date of the reference on which the rejection is based. 37 CFR §1.131(a) (2005). However, prior invention may not be established if the rejection is based upon a reference which claims the same patentable invention as defined in 37 CFR §41.203(a), in which case an applicant may suggest an interference. 37 CFR §1.131(a)(1) (2005).

37 CFR §41.203(a) states "[a]n interference exists if the subject matter of a claim of one party would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing part *and vice versa*." (Emphasis added). Under this two-way test, invention "A" is the same patentable invention as an invention "B" only when invention "A" anticipates or makes obvious invention "B," and invention "B" anticipates or makes obvious invention "A." *Eli Lilly v. Bd. of Regents of the Univ. of Wash.*, 334 F.3d 1264, 1268 (Fed. Cir. 2003). This

Application No. 09/726,589
Appeal Brief
September 6, 2005

two-way unpatentability test has always been used by the US PTO to determine whether claimed inventions interfere. 69 Fed. Reg. 49969 (August 12, 2004). The one-way unpatentability test has never been the standard for interfering subject matter and has been rejected by the US PTO as "unworkable." 69 Fed. Reg. 49992.

Importantly, the fact that the patent may *disclose* subject matter claimed by an applicant is not a basis for interference if the patent does not *claim* that subject matter. *Manual of Patent Examining Procedure (MPEP)*, §2306 (8th ed. 2004).

II

Applicants submitted, together with the February 11, 2004 Amendment, a Declaration under 37 CFR 1.131 showing that the claimed invention was made prior to July 2, 1999, which was the filing date of the *Sander* patent.

The Declaration can be used under 37 CFR §1.131(a)(1) to establish prior invention over *Sander*, because under the two-way unpatentability test *Sander's* claimed invention is not the same as Applicants' claimed invention. For example, *Sander's* claimed invention does not anticipate or make obvious Applicants' claimed invention.

With respect to Applicants' independent Claim 1, *Sander's* claimed invention does not teach or suggest three stamped parts that lie flat *sandwiched* against one another. *Sander* claims a first flat latching part and additional flat latching parts, but does not claim that the latching parts are sandwiched against one another. Additionally, the three stamped parts of Applicants' Claim 1 each have at least two engagement holes. *Sander*, on the other hand, claims only "openings formed in the additional parts," but does not claim that the first flat latching part has any engagement holes. Furthermore, Applicants' Claim 1

Application No. 09/726,589
Appeal Brief
September 6, 2005

recites that the engagement holes in the stamped parts are arranged *congruently* with respect to one another. *Sander* does not claim this limitation.

With respect to Applicants' independent Claim 20, *Sander* does not claim "at least three stamped metal sheet parts stacked together *sandwiched*." *Sander* also does not claim "*each* of said metal sheet parts including at least one engagement hole." And *Sander* does not claim that the engagement holes are "*aligned*."

Consequently, each of the rejected independent claims (i.e. Claims 1 and 20) is not the same as any of *Sander's* claims under the two-way unpatentability test. And each of the rejected dependent claims (i.e. Claims 4, 8, 24, and 25), therefore, is also not the same as any of *Sander's* claims.

III

The Examiner raised several arguments in the final Office Action dated November 3, 2004 (see paragraphs 1 and 3 on page 5). However, these arguments are insufficient to establish that *Sander's* claimed invention is the same as Applicants' claimed invention under the two-way unpatentability test.

First, the Examiner stated that "reasons are not required to reject the claims when the language of the claim have been anticipated by the reference and discussed in the rejections." (See paragraph 1 on page 5 of the Office Action dated November 3, 2004.) This statement was made in response to Applicants' argument that the Examiner had failed to provide reasons to support that *Sander's* claimed invention is the same as Applicants' invention. It is not clear to Applicants what the Examiner meant by this statement. And the Examiner provided no legal authority to support this statement. Therefore, this statement does not establish that *Sander's* claimed invention is the same as Applicants' invention.

Application No. 09/726,589
Appeal Brief
September 6, 2005

It should be noted again that under 37 CFR §1.131(a)(1) a declaration may not be used if the rejection is based upon a reference which *claims* the same invention. In such a case, interference should be declared. The MPEP also makes it clear that the fact that the patent may disclose an applicant's claim is not a basis for interference if the patent does not claim that subject matter. *MPEP*, §2306. Therefore, *Sander's* disclosure, if not claimed, cannot be used in the two-way unpatentability test.

Second, the Examiner argued that for anticipation the reference must teach the claimed invention either explicitly or impliedly. He then proceeded to argue that it is implied that the sheet parts of *Sander* are sandwiched. (See paragraph 2 on page 5 of the Office Action dated November 3, 2004.) For the following reasons Applicants respectfully disagree.

The Examiner's arguments are wrong in law because he used the wrong legal standard, "impliedly," for anticipation. "A claim is anticipated only if each and every element as set forth in the claim is found, either *expressly* or *inherently* described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). To establish inherency, the missing limitation must be *necessarily* present in the reference, and it would be so recognized by persons of ordinary skill in the art. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Inherency may not be established by probabilities or possibilities. *Id.* Therefore, the "impliedly" standard is not part of the test for anticipation.

Even under the Examiner's own "impliedly" standard, his arguments are insufficient to establish anticipation, because he failed to provide any explanation why it is implied that the sheet parts of *Sander* are sandwiched. The MPEP requires that the Examiner properly communicate the basis for a rejection so that an applicant can be given fair opportunity to reply. *MPEP*,

Application No. 09/726,589
Appeal Brief
September 6, 2005

§706.02(j). The MPEP further requires that where a claim is refused for any reason relating to the merits thereof the ground of rejection should be fully and clearly stated. *MPEP*, §707.07(d).

The Examiner's third argument is that the claims of *Sander* and Applicants' claims are "obvious variants." Again the Examiner failed to provide any explanation for his argument. As stated previously, such an argument does not provide fair opportunity for Applicants to reply, and is insufficient to support a rejection.


IV

For the foregoing reasons, the rejection of Claims 1, 4, 8, 20, 24, and 25 under 35 U.S.C. §102(e) as being anticipated by *Sander* is in error, and the Board is respectfully requested to reverse the rejection.

The Commissioner is hereby authorized to charge the \$500.00 Appeal Brief fee, along with any other requisite fees, to Deposit Account No. 05-1323, Docket No.: 038738.49427US.

Respectfully submitted,

September 6, 2005



Song Zhu, Ph.D.
Registration No. 44,420

CROWELL & MORING LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844
SZ:tlm (390451)

Application No. 10/048,277
Appeal Brief
August 8, 2005

Claims Appendix

The claims on appeal read as follows:

1. A functional component as a gate plate of an automatic gear shift mechanism with a locking gate, having engagement holes for engagement elements which kinetically interact with the functional component, wherein the functional component comprises at least three stamped parts, which lie flat sandwiched against one another, are unreleasably connected to one another and each have at least two engagement holes for engagement elements which kinetically interact with the functional component, the engagement holes in the stamped parts being arranged congruently with respect to one another, at least one of said holes, in a middle one of the stamped parts, having a hole wall which is provided with an elastomeric plastic cover.

4. Functional component according to Claim 1, wherein the plastic cover is formed by injection-moulding plastic around a hole edge.

8. Functional component according to Claim 4, wherein spacer lugs are formed from a material which is harder than the injection-moulded plastic on inner sides, of the outer stamped parts which face towards the middle stamped part.

20. A gate plate for an automatic gear shift mechanism which has engagement holes for glidingly accommodating movable gear shift mechanism engagement elements, comprising:

at least three stamped metal sheet parts stacked together sandwiched, each of said metal sheet parts including at least one engagement hole aligned with engagement holes in the other metal sheet parts,

and an elastomeric plastic cover provided to surround at least a portion of the engagement hole in a middle one of the metal sheet parts.

Application No. 10/043,277
Appeal Brief
August 8, 2005

24. A gate plate according to Claim 20, wherein the elastomeric plastic cover is clicked into place on said metal part.

25. A gate plate according to Claim 20, wherein the elastomeric plastic cover is injection-moulded onto the middle part.